



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,434	06/05/2001	Yining Deng	10006290-1	7733

7590 05/19/2005

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

ZHU, JERRY

ART UNIT	PAPER NUMBER
----------	--------------

2129

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/875,434	DENG ET AL.	
	Examiner	Art Unit	
	Jerry Zhu	2129	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 1-7 are directed to non-statutory subject matter. They are not claimed to be practiced on a computer or any other concrete and tangible technology, therefore, it is clear that the claims are not limited to practice in the technological arts. On that basis alone, they are clearly nonstatutory.
2. Regardless of whether any of claims 1-7 are in the technological arts, none of them is limited to practical applications in the technological arts. The examiner finds that *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994) controls the 35 USC §101 issues on that point for reasons made clear by the Federal Circuit in *AT&T Corp. v. Excel Communications, Inc.*, 50 USPQ2d 1447 (Fed. Cir. 1999). Specifically, the Federal Circuit held that the act of:

...[T]aking several abstract ideas and manipulating them together adds nothing to the basic equation. *AT&T v. Excel* at 1453 quoting *In re Warmerdam*, 33 F.3d 1354, 1360 (Fed. Cir. 1994).

The examiner finds that Applicant's "sequential progression of decision making, algorithm, learning" references are just manipulations of mathematic algorithms in tree like structure is just an abstract idea.

3. The examiner bases his position upon guidance provided by the Federal Circuit in *In re Warmerdam*, as interpreted by *AT&T v. Excel*. This set of precedents is within the same line of cases as the *Alappat-State Street Bank* decisions and is in complete agreement with those decisions.

Warmerdam is consistent with *State Street's* holding that:

Today we hold that *the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price*, constitutes a practical application of a mathematical algorithm, formula, or calculation because it produces 'a useful, concrete and tangible result' -- *a final share price momentarily fixed for recording purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.* (emphasis added) *State Street Bank* at 1601.

Art Unit: 2129

4. True enough, that case later eliminated the “business method exception” in order to show that business methods were not per se nonstatutory, but the court clearly *did not* go so far as to make business methods *per se statutory*. A plain reading of the excerpt above shows that the Court was *very specific* in its definition of the new *practical application*. It would have been much easier for the court to say that “business methods were per se statutory” than it was to define the practical application in the case as “...the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price...”
5. Additionally, the court was also careful to specify that the “useful, concrete and tangible result” it found was “a final share price momentarily fixed for recording purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.” (i.e. the trading activity is the further practical use of the real world monetary data beyond the transformation in the computer - i.e., “post-processing activity”.)
6. Applicant cites no such specific results to define a useful, concrete and tangible result. Neither does Applicant specify the associated practical application with the kind of specificity the Federal Circuit used.
7. Furthermore, in the case *In re Warmerdam*, the Federal Circuit held that:

...[T]he dispositive issue for assessing compliance with Section 101 in this case is whether the claim is for a process that goes beyond simply manipulating 'abstract ideas' or 'natural phenomena' ... As the Supreme Court has made clear, '[a]n idea of itself is not patentable, ... taking several abstract ideas and manipulating them together adds nothing to the basic equation'. In re Warmerdam 31 USPQ2d at 1759 (emphasis added).

8. Since the Federal Circuit held in *Warmerdam* that this is the “dispositive issue” when it judged the usefulness, concreteness, and tangibility of the claim limitations in that case, the examiner in the present case views this holding as the dispositive issue for determining whether a claim is “useful, concrete, and tangible” in similar cases. Accordingly, the Examiner finds that Applicant manipulated a set of abstract ideas “a plurality of classification nodes” to solve purely algorithmic problems in the claims. Clearly, these classification nodes indicated in claims 1-7 are merely organizing pure “mathematical algorithms” which the Supreme Court has held are per se nonstatutory - in fact, it *includes* the expression of nonstatutory mathematical algorithms.
9. Since the claims are not limited to exclude such abstractions, the broadest reasonable interpretation of the claim limitations includes such abstractions. Therefore, the claims are impermissibly abstract under 35 U.S.C. 101.

Art Unit: 2129

10. Since *Warmerdam* is within the *Alappat-State Street Bank* line of cases, it takes the same view of “useful, concrete, and tangible” the Federal Circuit applied in *State Street Bank*. Therefore, under *State Street Bank*, this could not be a “useful, concrete and tangible result”. There is only manipulation of abstract ideas.
11. The Federal Circuit validated the use of *Warmerdam* in its more recent *AT&T Corp. v. Excel Communications, Inc.* decision. The Court reminded us that:

Finally, the decision in *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994) is not to the contrary. *** The court found that the claimed process did nothing more than manipulate basic mathematical constructs and concluded that ‘taking several abstract ideas and manipulating them together adds nothing to the basic equation’; hence, the court held that the claims were properly rejected under §101 ... Whether one agrees with the court’s conclusion on the facts, the holding of the case is a straightforward application of the basic principle that mere laws of nature, natural phenomena, and abstract ideas are not within the categories of inventions or discoveries that may be patented under §101. (emphasis added) *AT&T Corp. v. Excel Communications, Inc.*, 50 USPQ2d 1447, 1453 (Fed. Cir. 1999).

12. Remember that in *In re Warmerdam*, the Court said that this was the dispositive issue to be considered. In the *AT&T* decision cited above, the Court reaffirms that this is the issue for assessing the “useful, concrete, and tangible” nature of a set of claims under section 101. Accordingly, the examiner views the *Warmerdam* holding as the dispositive issue in this analogous case.
13. The fact that the invention is merely the manipulation of *abstract ideas* is clear. The data referred to by Applicant’s phrase “classification tasks” is

simply an abstract construct that does not limit the claims to the transformation of real world data (such as monetary data or heart rhythm data) by some disclosed process. Consequently, the necessary conclusion under *AT&T*, *State Street* and *Warmerdam*, is straightforward and clear. The claims take several abstract ideas (i.e., "algorithm for each of classification tasks" in the claims) and manipulate them together adding nothing to the basic equation. Claims 1-7 are, thereby, rejected under 35 U.S.C. 101.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

14. Claims 1-7 are rejected under 35 USC 112, first paragraph because current case law (and accordingly, the MPEP) require such a rejection if a 101 rejection is given because when Applicant has not in fact disclosed the practical application for the invention, as a matter of law there is no way Applicant could have disclosed *how* to practice the *undisclosed* practical application. This is how the MPEP puts it:

("The how to use prong of section 112 incorporates as a matter of law the requirement of 35 U.S.C. 101 that the specification disclose as a matter of fact a practical utility for the invention.... If the application fails as a matter of fact to satisfy 35 U.S.C. § 101, then the application also fails as a matter of law to enable one of

Art Unit: 2129

ordinary skill in the art to use the invention under 35 U.S.C. § 112."); In re Kirk, 376 F.2d 936, 942, 153 USPQ 48, 53 (CCPA 1967) ("Necessarily, compliance with § 112 requires a description of how to use presently useful inventions, **otherwise an applicant would anomalously be required to teach how to use a useless invention.**"). See, MPEP 2107.01(IV), quoting In re Kirk (emphasis added).

Therefore, claims 1-7 are rejected on this basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

15. Claim 9, 14-15, 17, 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Shaffer. Specifically

Claim 9

16. Shaffer teaches a method of categorizing files of non-textual data comprising the steps of:
- establishing a sequential progression of decision making using automated processing techniques to define a dependent arrangement

of steps (which are equivalent to task nodes) that assign classes to a data file. Some of the nodes have algorithms for determining next step of progression (para29, lines 6-20; para31, lines 28-57). (The processing goal at each step would include assigning classes to the steps or nodes, and determining what is next step or node of the progression. The processing modules are equivalent to the algorithms at the nodes.) . Some of the classification nodes have a plurality of software algorithms whose operations include grouping, processing metadata and image data (para31, lines 55-65)

- receiving a file of non-textual data (para 25, lines 21-24)
- processing a file of non-textural subject data through the sequential progression of decision making to selectively identify a plurality of classifiers associated with the file of non-textual subject data (para 32).

Claims 14

17. Shaffer teaches a method for classifying a data file at a classifying node comprising the steps:

- Subjecting an image data file to a transformation function to generate transformed image data (para 31, lines 61-64)
- Performing feature analysis (para 28)
- Applying an algorithm routine to generate a class identifiable (para 32)

Claim 15

Art Unit: 2129

18. Shaffer teaches selecting algorithm routine from a plurality of algorithm routines (para31, lines 55-65).

Claim 17

19. Shaffer teaches selection of algorithmic routine based on the determination of previous classification task (para29, lines 6-20).

Claim 18

20. Shaffer teaches the step of performing feature analysis (para 31, lines 61-64)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 1, 8, 10-13 and 16 are rejected under 35 U.S.C. 103(a) as being obvious over Shaffer et, al. U.S. Pub. No. 2001/0046330 (Shaffer) in view of Wical et, al. U.S. Pat. No. 6101515 (Wical).

Claim 1

22. Shaffer discloses a system for classifying subject data (para 25, lines 1-6) comprising:

- a sequential progression of decision making with processing modules at each step of the progression to satisfy processing goal of that step (para29, lines 6-20; para31, lines 28-57). (The processing steps are equivalent to classification nodes. The processing goal at each step would include assigning classes to the steps or nodes, and determining what is next step or node of the progression. The processing modules are equivalent to the algorithms at the steps or nodes.)
- a variety of software algorithms whose operations include grouping, processing metadata and image data(para31, lines 55-65). (Sub-algorithms, such as performing image analysis, can be considered as one class of algorithms called by another class of algorithms.)

Shaffer fails to teach a learning procedure for modifying the arrangement of classification tasks.

Wical teaches a learning system that provides automated means for learning words and phrases from a set of documents by classifying the terms in categories of a classification system (col. 3, lines 13-67; col. 4,

lines 1-40). The terms derived from meta-data and image analysis can be used as words and phrases for learning to determine classification parameters and classifiers. One of ordinary skill in the art would have provided the learning system taught by Wical, for the purpose of automating the learning procedure to classify the terms into categories of a classification system. As a result it would have been obvious to one of ordinary skill in the art at the time of applicants' invention to modify the system taught by Shaffer by adding the learning system as taught by Wical.

Claim 8

23. Shaffer discloses a system for classifying subject data that includes a recording device for capturing non-textual subject data (para 25, lines 21-24) and for recording meta-data, the meta-data being specific to an operational mode of the recording device during capturing of the non-textual subject data (para 27, lines 14-23);

Claim 10-12

24. Shaffer teaches grouping images by image content and metadata as stated in claim 9. Shaffer does not teach a learning procedure. However, Wical teaches a learning system that provides automated means to extract and process learning words and phrases from a set of

documents by classifying them in categories of a classifications system (col. 3, lines 13-67; col. 4, lines 1-40) comprising:

- extracts content-based data (col. 20, lines 36-56) from a set of documents.
- generates learning classes that are descriptive to training images through content analysis. (col. 7, lines 23-52) (col. 8, lines 23-46) (Wical analyzes content using content processing system, generates learning classes using knowledge catalog that maybe semantic and lexical derivatives)
- dynamically modifying sequential progression of decision making and monitoring and adjusting the determinations of classification (col. 2, lines 15-27).
- One of ordinary skill in the art would have provided the learning procedure of Wical using a plurality of learning images, for purpose of establishing a learning classification system. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the learning procedure of Wical using a plurality of learning images, for purpose of establishing a learning classification system to recognize a query image.

Claim 13

25. Shaffer teaches the step of performing the automated processing includes assigning a semantic expression to the non-textual data for use at least

one descriptor for one of organizing file (para40, lines 7-23) and matching a query during a search for said file (para 34, lines 8-31).

Claim 16

26. Shaffer teaches algorithm for generating class (para29, lines 6-20) (one of the processing goals of for that step or node would be to assign a class to the node). Shaffer does not teach learning procedure. Wical teaches a learning system that provides automated means for learning words and phrases from a set of documents by classifying the terms in categories of a classifications system (col. 3, lines 13-67; col. 4, lines 1-40). It would be obvious for an ordinary skill in the art to combine Shaffer and Wical to define an algorithm that integrate the learning procedure into the algorithm to generate class based on training images.

27. Claims 2-7 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Shaffer in view of Wical as set forth in the rejection of claims 1, 8 and 10 above, and further in view of Provino et al. U.S. Pat. No. 5,778,384 (Provino).

Claim 2-7

28. Provino discloses a system and method for facilitating the access of file systems or storage systems in network environment comprising:

system for the purpose of identifying proper sequence of module to execute and to provide classification of data.

Response to Arguments

Applicants remarks filed on March 23, 2005 have been reviewed by Examiner but are found to be unpersuasive. Specifically, Applicant argues four things:

Patentability of Claims 1-7 Under 35 U.S.C. 101

Applicant has two arguments:

1. Technological embodiment by adding a computer readable medium having computer executable software. Claim 1, therefore, is limited to practice in the technological art.
2. Assigning of classes to an individual file of non-textual subject data. Claim 1, therefore, has a practical application.

Examiner agrees with the first argument regarding concreteness of technological embodiment. Examiner does not agree with the second argument that the amended claim 1 is limited to a practical application. It is not clear what practical application the individual file of non-textual subject data is limited to. (i.e. what is the "real world" value the file produces? What is the context the file is used? Computer game or share price trend?)

Further, the amendment does not change the fact that the subject matter still represents nothing more than an idea or concept, or is simply a starting point for future

Patentability of Claims 1-7 Under 35 U.S.C. and 112

Applicant has two arguments:

1. Technological embodiment by adding a computer readable medium having computer executable software. Claim 1; therefore, is limited to practice in the technological art.
2. Assigning of classes to an individual file of non-textual subject data. Claim 1, therefore, has a practical application.

Examiner agrees with the first argument regarding concreteness of technological embodiment. Examiner does not agree with the second argument that the amended claim 1 is limited to a practical application. It is not clear what practical application the individual file of non-textual subject data is limited to. (i.e. what is the "real world" value the file produces? What is the context the file is used?

Computer game or share price trend?)

Further, the amendment does not change the fact that the subject matter still represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); In re Ziegler, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). Concrete embodiment using technological art (such as using computer to solve math equations) does not change the status of the idea being abstract or intangible. (i.e. the sequential progression of decision making is nothing more than a mathematic algorithm, hence an abstract idea). Also tangible idea may not be useful. (i.e. A flying sausage is both concrete and tangible but lack of asserted utility)

The amended claim 1 has addressed the concreteness of technological embodiment but fail to meet the tangible and usefulness requirements. It is obvious that the claim does not limit the claimed invention to statutory material and the rejections made by Examiner in the non-final rejection were proper.

Patentability of Claim 1 under 35 U.S.C. 103 (a)

Applicant has three arguments:

1. No teaching in Shaffer regarding the selection of algorithms available at any particular process step.
2. No teaching in Shaffer regarding the invoking an algorithm by accessing an algorithm component which selects a specific algorithm
3. No teaching in Shaffer that a sub-algorithmic component selects a sub-algorithm routine for a specific grouping algorithm having a plurality of grouping sub-algorithms.

Applicant agreed that multiple algorithms exist at each step and one is executed.

One algorithm must be selected and executed hence there is a selection of algorithm available at any process step. Hence argument 1 does not stand.

Applicant's arguments of algorithm component selecting other algorithms and sub-algorithm selecting other sub-algorithms are software design choice and implementation detail and hence contribute little to patentability argument.

Applicant's components and Shaffer's processing modules are computer software modules that can be grouped and compiled into arbitrary files in arbitrary levels (hence components, sub-components, modules, and sub-

Art Unit: 2129

modules). Therefore, it is obvious that the rejections made by Examiner in the patentability rejection under 35 U.S.C. 103(a) were proper.

Patentability of Claim 9 under 35 U.S.C. 102

Applicant has three arguments:

1. No teaching in Shaffer that algorithm selected by an algorithmic component

Like claim 1, Applicant added algorithm component to perform selection in claim 9 and argues that Shaffer teaches that algorithm selection is performed by the node rather than by the algorithm component. Again, node and components are computer software concepts and can be designed and implemented in many different ways and they do not contribute to patentability argument under 35 U.S.C. 102. Therefore, it is obvious that the rejections made by Examiner in the patentability rejection under 35 U.S.C. 102 were proper.

Patentability of Claim 14 under 35 U.S.C. 102

Applicant has three arguments:

1. No teaching in Shaffer that data or file produced by one node to be used by another node

Applicant added in claim 14 data or file produced by one node to be used by another node. Again, nodes are computer software concepts that control the

Art Unit: 2129

procedure flow and software encapsulation. Different ways of grouping software components into different nodes change the communication between nodes. They are software design choice and implementation detail, and hence do not contribute to patentability argument under 35 U.S.C. 102. Therefore, it is obvious that the rejections made by Examiner in the patentability rejection under 35 U.S.C. 102 were proper

Conclusion

This Action Is Made Final. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to the examiner's supervisor, Anthony Knight whose telephone number is (571) 272-3687.

Art Unit: 2129

Jerry Zhu

Examiner

Art Unit - 2129

Tuesday, May 03, 2005

Wilbert L. Starks, Jr.
Primary Examiner
Art Unit - 2121

Wilbert L. Starks, Jr.

Wilbert L. Starks, Jr.
Primary Examiner
Art Unit - 2121